



R-2000-101

OCT 11 2000

Decision on Petition for Regrade Under 37 CFR 10.7(c)

(petitioner) requests for regrading questions 7 and 35 of the morning section and questions 6 and 18 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 69. On August 4, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

However, no credit has been awarded for morning questions 7 and 35 and afternoon questions 6 and 18. Petitioner's arguments for these questions are addressed individually below.

Morning question 7 reads as follows:

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

- Claim 1. An apparatus for shearing sheep, said apparatus comprising:
- (i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;
 - (ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;
 - (iii) _____;
 - (iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.
- Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.
- Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

- (A) "wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and"
- (B) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"
- (C) "said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends, said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"
- (D) "said first cutting member and said second cutting member being pivotally secured to each other by a connector; and"
- (E) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting

member and said second cutting member are pivotally secured to each other at their respective mid-points; and”

The model answer is (B). Answer B provides proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2, and “said connector” in Claim 3.

Petitioner selected answer D. Petitioner argues that choice D is the best answer because the question asks which of the following **most broadly** completes the missing paragraph in the claim and it did not require the answer to provide proper antecedent basis. Petitioner concludes that the best choice would be a statement that most broadly completes the claim regardless it provides proper antecedent basis or not.

Petitioner’s arguments have been fully considered but they are not persuasive. As indicated in the instruction, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. 35 U.S.C. § 112, second paragraph, requires that the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his inventions. Also see MPEP 706.03(d). A claim is indefinite when it lacks antecedent basis. See form paragraph 7.34.05 *Lack of Antecedent Basis in the Claims*, page 700-33 of the MPEP, and MPEP 2173.05(e). Accordingly, answer D is incorrect because the claim would not be in accordance with 35 U.S.C. § 112, second paragraph. It does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in

Claim 2. Choice B is the best answer because it provides a statement that most broadly completes the claim with proper antecedent basis.

Morning question 35 reads as follows:

35. On July 1, 1998, a registered practitioner files an application containing 10 claims that are directed to a computer. The practitioner thereafter receives an Office action wherein claims 1 - 5 are properly rejected under 35 U.S.C. § 102 based upon reference A dated January 3, 1999. Reference A is an abstract identifying a computer, the computer's vendor, and information informing potential buyers whom to contact, price terms, documentation, warranties, training and maintenance programs, and the date of the computer's release to the public. In sufficient detail to meet the requirements of 35 U.S.C. § 112, reference A describes a computer having all of the elements of the rejected claims. According to reference A, the computer described therein was publicly sold in the United States in June 1997. As a practitioner, what should you advise your client to do in accordance with proper PTO practice and procedure?

- (A) File a reply arguing that Reference A cannot constitute prior art since it is dated subsequent to the filing date of the application.
- (B) File an amendment canceling the rejected claims and argue patentability of the remaining claims.
- (C) Argue that reference A constitutes hearsay evidence because there is no direct evidence that the computer of Reference A was actually in existence in June 1997.
- (D) Argue that even if the computer of Reference A was in existence in June 1997, the failure to disclose the invention until 1999 constituted abandonment of the invention.
- (E) Request a public use hearing to determine if there actually was public use in June 1997.

The model answer is choice (B). A practitioner should file an amendment canceling the rejected claims and argue patentability of the remaining claims.

Petitioner selected answer (C). Petitioner argues that choice C is correct because reference A is a "hearsay" which is not a prior art publication within the meaning of 35 U.S.C. § 102(a) and the product may or may not be actually in existence in June 1997. Petitioner also argues that a practitioner should represent a client zealously within the bounds of the law and should not cancel the rejected claims as in answer B.

Petitioner's arguments have been fully considered but they are not persuasive. Choice C is incorrect because no evidence has been offered to demonstrate that reference A is not accurate. PTO is not precluded from relying upon hearsay evidence in making rejections during a patent *ex parte* examination proceeding. *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994). In *Epstein*, the Court affirmed a "in public use or on sale" rejection under 35 U.S.C. § 102(b) based on abstracts that were published after the application filing date. While the practitioner may investigate and present rebuttal evidence under 37 CFR 1.132, answer C does not include such evidence. Therefore, answer C is not correct.

A practitioner may represent a client zealously within the bounds of the law. A practitioner, however, should not make frivolous argument without presenting substantive evidence. The case law is clear that such rejection as the facts given in this question would not be overcome with argument alone. Applicant must present evidence to rebut the rejection, not simply argue that the reference constitutes hearsay. See MPEP §§ 716.07 and 2133.03 (b), page 2100-64 and *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994). Hence, choice B is the best answer.

Afternoon question 6 reads as follows:

6. In the course of prosecuting a patent application for his client, Smith did not receive a Notice of Allowance and Issue Fee Due from the PTO. Fifteen months after submitting a reply to a final rejection, Smith received from the PTO a Notice of Abandonment advising that the application became abandoned for failure to pay the issue fee. Which of the following actions, if any, accords with proper PTO practice and procedure, and is most likely to succeed in protecting the interests of Smith's client?

- (A) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a), was unavoidable, accompanied by the issue fee then in effect, and any required terminal disclaimer.

- (B) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional, and required terminal disclaimer.
- (C) File a timely petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.
- (D) All of the above.
- (E) None of the above.

The model answer is choice is (C). To properly revive an abandoned application that went abandoned because the practitioner did not receive a mailing from the office, practitioner should timely file a petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.

Petitioner selected answer (B). Petitioner argues that answer B is correct because filing a petition to revive the abandoned application under 37 CFR 1.137(b) is more likely to protect the interests of Smith's client. According to petitioner, the showing under petition to withdraw holding of abandonment is more difficult to make than a statement under a 37 CFR 1.137(b) petition. Petitioner further argues that section 7.1103(c) III of the MPEP (under the heading "B. Petition Fee Requirement) is not clear if a fee is due because it states "unless the circumstances warrant the withdrawal of the holding of the abandonment, the payment of a petition fee to

obtain the revival of an abandoned application is a statutory prerequisite to revival of the application . . .”

Petitioner’s arguments have been fully considered but they are not persuasive. A petition to revive an abandoned application under 37 CFR 1.137 should not be confused with a petition to withdraw the holding of abandonment under 37 CFR 1.181(a). A petition to withdraw the holding of abandonment does not require a fee as stated in MPEP 711.03(c) subsections I and III. However, the petition fee for reviving an abandoned application is required at the time of filing the petition. See 35 U.S.C. § 41(a)(7) and MPEP 711.03(c) III, page 700-89, right column. A petition under 37 CFR 1.137(b) must accompanied by the petition fee as set forth in 37 CFR 1.17(m). See 35 U.S.C. § 41(a)(7), 37 CFR 1.137(b)(2), and MPEP 711.03(c), page 700-87, right column. Accordingly, choice B is not correct because the petition to revive under 37 CFR 1.137(b) in choice B is not accompanied by the petition fee as required by 37 CFR 1.137(b)(2). Furthermore, answer C is correct because the petition to withdraw the holding of abandonment does not require a petition fee and it sets forth the showing as required in MPEP 711.03(c), subsection II.

Afternoon question 18 reads as follows:

18. Which of the following statements regarding a registered practitioner is most correct?

- (A) An unsubstantiated argument by a practitioner that applicant discovered the problem is insufficient to show that applicant discovered the source of the problem.
- (B) An unsubstantiated argument by a practitioner that the invention provides a solution of a long-felt need is insufficient to show that the invention fills a long-felt need.
- (C) Where an examiner has advanced a reasonable basis for questioning the adequacy of disclosure, an argument by a practitioner that the application meets the requirements of 35 U.S.C. § 112, first paragraph, is entitled to little, if any weight,

in the absence of facts supporting a basis for deciding that the specification complies with 35 U.S.C. § 112, first paragraph.

- (D) An argument by a practitioner that the prior art reference is inoperative is insufficient to show the claimed subject matter is unobvious in the absence of objective evidence demonstrating inoperability of the prior art reference.
- (E) Each of (A), (B), (C), and (D) is correct.

The model answer is choice is (E). Each of (A), (B), (C), and (D) are correct statements regarding registered practitioners.

Petitioner selected answer (C). Petitioner argues that the model answer is not correct because the question ask which statement is most correct, requiring a selection or ranking. The question implies one answer is better than the rest, therefore petitioner's answer is better than the model answer, as it answers the question posed.

Petitioner's arguments have been fully considered but they are not persuasive. Answer C is not correct because it is incomplete. Selecting choice C as the answer indicates only that statement is correct. Since all the statements in choices A, B, C and D are correct, choice E is the best answer. See MPEP 2141.02 (subsection styled, "Applicants Alleging Discovery Of A Source Of A Problem Must Provide Substantiating Evidence"); *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). (B) and (C) are correct. See MPEP 716.01(c); *In re Knowlton*, 500 F.2d 566, 572, 183 USPQ 33, 37 (CCPA 1974) (where the record consisted substantially of arguments and opinions of applicant's attorney, the court indicated that factual affidavits could have provided important evidence on the issue of enablement). Arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re*

Schulze, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). (D) is correct. MPEP 716.01(c) and 2145.

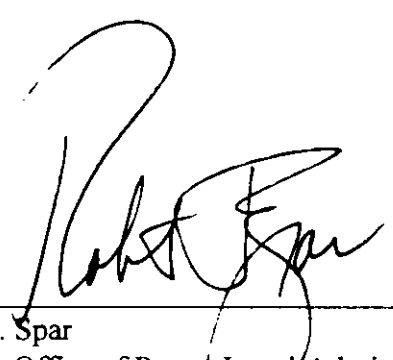
No error in grading has been shown as to morning questions 7 and 35 and afternoon question 6 and 18. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy